

33. The method according to Claim 27, further comprising:
applying a coupling layer to the backside of the sheet metal
part; and

heating or activating the coupling layer with the injection
molding compound.

34. The method according to Claim 33, wherein the coupling
layer is a reactive hot-melt-type adhesive or a dry glue film.

A. Hunt 35. The method according to Claim 27, further comprising
embedding fastening elements for the covering or trim part in the
injection molding compound.

36. The method according to Claim 27, wherein the closing
of the mold comprises simultaneously cutting and stamping the
decor part.

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 1-26 are pending in this Application. Claims 12-26
have been withdrawn from consideration as being drawn to a non-
elected invention. By this amendment, new Claims 27-36 are added
to this Application. Support for Claims 27-36 can be found in
the bridging paragraph between pages 8 and 9 of the
Specification.

Restriction Requirement:

Applicants affirm the provisional election with traverse to
prosecute the invention of Group I, Claims 1-11. This

restriction requirement is respectfully traversed because there is no serious burden on the examiner if restriction is not required.

A search of all three groups of claims will not cause an undue burden on the examiner. Therefore, reconsideration and withdrawal of the restriction requirement are respectfully requested.

Rejection Over Prior Art:

Claims 1 and 11 were rejected under 35 U.S.C. 102(b) over the Masui et al U.S. Patent (US 5,223,201). This rejection is respectfully traversed.

The Masui et al patent discloses a method for manufacturing a laminated body consisting of an upper layer member 10 and a synthetic resin body 11 by the interaction of a male and female mold. The Matsui patent discloses a method where after the upper layer member is placed on the slideable frame, the mold is closed and the molten resin is injected. The female mold and the slide frame are then moved downward toward the male mold (see the individual process steps in col. 4, line 37, to col. 5, line 15). Only after this second movement is the laminated component fully formed. This differs from the process of the present invention, where after the mold is closed, no further movement of the two parts relative to one another takes place.

In addition, Masui discloses that the cutting step occurs after application of the synthetic resin (Column 2, lines 48-52). The cutting occurs just prior to or simultaneous with the completion of the shaping or forming of the layer member and the molten resin. It is mentioned the timing of the cutting produces three different laminated bodies (Column 5, lines 30-47). The

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Serial No. 09/296,276

three different laminated bodies are shown in Figures 6-8. Importantly, when the layer member is cut simultaneously with the resin, it is specifically stated that "upper layer member 10 may be imperfectly cut, and the cutting may be perfected by hand pulling after the molding".

The process of the present invention recites that the mold is closed (no further movement of the mold takes place) and this cuts the decor part to precise contours in the injection mold. This step eliminates the need for the aftertreatment of decor part which requires great expense and time. Thus, for the all the reasons presented above, the Masui patent teaches away from the process claimed in the present invention. Consequently, Claim 1 fails to read on the Masui patent.

Claims 2-3 are allowable since they depend on Claim 1 which is patentable over the Masui patent.

Claims 4-7 were rejected under 35 U.S.C. 103(a) over the Masui et al U.S. Patent (US 5,223,201) in view of the Kato et al U.S. Patent (US 5,225,264). This rejection is respectfully traversed.

The Masui patent discloses that the upper layer member 10 is limited to the following materials: woven stuff, unwoven stuff, metal, fiber, thermoplastic resinous net, paper, metal foil or sheet or film of thermoplastic resin and thermoplastic elastomer, i.e., soft, movable, thin layers (see col. 6, lines 40 to 44). There is no teaching or suggestion of a process that can be used with solid parts of wood or metal as in the process of the present invention. Accordingly, contrary to the Examiner's contention, this patent fails to provide the requisite

not limited
can be used

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motivation for combination with the Kato et al patent. The Examiner cannot ignore this and must consider a patent in its entirety including those portions which teach away from the present invention *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), cert. denied, 469 U.S. 851, 105 S.Ct. 172 (1984). The Masui patent fails to disclose a process in which a wood veneer or metal sheet could be used. Thus, for all the above reasons, Claims 4-7 are patentable over the Masui et al U.S. Patent (US 5,223,201) in view of the Kato et al U.S. Patent (US 5,225,264).

Claims 8-9 were rejected under 35 U.S.C. 103(a) over the Masui et al U.S. Patent (US 5,223,201) in view of the Conner U.S. Patent (US 4,369,157). This rejection is respectfully traversed.

The Conner patent discloses a vacuum metallizing layer and not a **sheet metal part**. The optional metallizing layer of Conner provides a metallic hue to the product. It is obvious that these are not equivalent parts and each offers it own unique problems to an injection mold process.

In addition, as stated above, the Masui patent teaches away from use of a sheet metal part as a decor part. Thus, the Masui patent fails to provide the requisite motivation for combination with the Conner patent.

Claim 10 was rejected under 35 U.S.C. 103(a) over the Masui et al U.S. Patent (US 5,223,201) in view of the Stickling U.S. Patent (US 5,525,179). This rejection is respectfully traversed.

Claim 10 is allowable since it depends on Claim 1 which is patentable over the Masui patent, and Stickling fails to remedy the deficiency of the Masui patent.

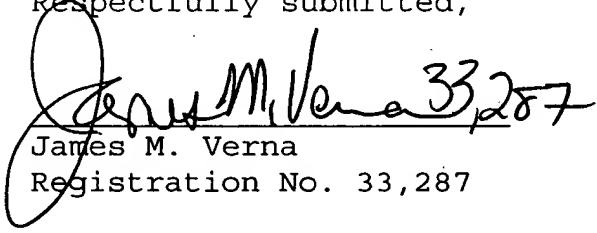
In sum, none of the references, either individually or in combination, teach or suggest the present invention as recited in Claims 1-11 and new Claims 27-36. Therefore, reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing amendments and remarks, the application is respectfully submitted to be in condition for allowance, and prompt, favorable action thereon is earnestly solicited. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #225/47721).

Respectfully submitted,

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